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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SANTIAGO CORDERO, MARIVELISSE

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

04/13/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/538,165	Applicant(s) HIDAKA, HIROYUKI	
	Examiner MARIVELISSE SANTIAGO-CORDERO	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/29/2010 has been entered.

Response to Arguments

2. Applicant's arguments filed on 3/2/2010 have been fully considered but they are not persuasive. All of Applicant's arguments (discussed below) were also addressed in the Advisory Action mailed on 3/11/2010.

The amendment to the specification is still objected to under 35 U.S.C 132(a) because it introduces new matter into the disclosure. Applicant argues that there is no reason for the objection to remain, given that the specification was amended to its previous form (Remarks: page 5, last paragraph). In response, the Examiner notes that the previous form was also objected to under 35 U.S.C 132(a) because it introduced new matter into the disclosure. See page 2 of Office Action mailed on 5/27/2009.

Furthermore, regarding the drawings, Applicant argues that Figure 3C is not prior art (Remarks: page 6, under "Drawing Objection"). In response, the Examiner respectfully disagrees. Applicant's original specification (page 7), under the "Brief Description of the Drawings" section, clearly stipulates that "Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a conventional suspend time", thus, considered an

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admission or prior art. Consequently, Figure 3C should be labeled with --Prior Art-- because only that which is old is illustrated and the objection to the drawings is maintained, i.e., Fig. 3C should be labeled with --Prior Art-- because only that which is old is illustrated.

Regarding claims 3, 4, 7, and 8, Applicant argues that Fig. 3C is not prior art, that the specification makes it clear that Fig. 3C is not prior art, and that the description simply does not support the Action's assertion that Fig. 3C is prior art; importantly, because the reference to "a conventional suspend time" in the brief description stating that Figs. 3A-3C illustrate one and only one conventional suspend time (i.e., is singular not plural) and those of ordinary skill in the art would understand, are Figs. 3A and 3B, and that, at best, the brief description cited by the office, by itself, is ambiguous as to whether Fig. 3C is "a convention suspend time" (Remarks: pages 6-9). In response, the Examiner respectfully disagrees. Applicant's original specification (page 7), under the "Brief Description of the Drawings" section, clearly stipulates that "Figs. 3A to 3C are timing charts showing processing performed in the lxEVDO system during a conventional suspend time". Contrary to being ambiguous, the specification explicitly states it. In addition, other portions of the original specification further support the Examiner's position. For example, page 13, lines 12-13, and page 14, line 11 through page 15, line 1, where it states that Figs. 3A to 3C show timing charts of communications using the suspend time in the lxEVDO system and Fig. 3C is a timing chart of a case where a suspend time is not set. Furthermore, Applicant's arguments referring to a portion of the specification contradicts the argument that Fig. 3C is not prior art and further supports the Examiner's position that Fig. 3C is prior art. That is, in page 10, last paragraph of the Remarks, Applicant argues that the specification makes clear that not setting the suspend time was understood by those in the art to deteriorate data

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communication and thus was to be avoided. This statement raises the following question: if not setting the suspend time was not prior art, as Applicant intends to argue, then how come not setting the suspend time was understood by those in the art to deteriorate data communication? This is clearly contradictory to Applicant's argument that Fig. 3C is not prior art and is therefore, an admission that not setting the suspend time (as in Fig. 3C) is prior art, because the specification, as applicant argues, makes it clear that not setting the suspend time was understood by those in the art to deteriorate data communication.

Applicant argues that even assuming *arguendo* that Fig. 3 of Applicant's specification constitutes prior art, the prior art of instant case teaches away from the proposed combination, because the Office's stated motivation of "conserving battery power" would not have motivated one of ordinary skill in light of the understanding of those skilled in the art that 'when the suspend time is not set, a throughput of data communication is deteriorated when the state of radio wave is not good" (Remarks: pages 9-11). In response, the Examiner respectfully disagrees. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The statement that "a throughput of data communication is deteriorated" is specific to the condition that the radio wave is not good. There is no indication in the specification that a throughput of data communication is deteriorated in all conditions, including when the radio wave is good. Although not setting the suspend time would deteriorate communication when the state of the radio wave is not good, as applicant intends to argue, it nevertheless provides the advantage of immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus,

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conserving battery power. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings." *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). The fact that Applicant does not set the suspend time for a different purpose (to not impact the communication performance) does not alter the conclusion that not setting it would be *prima facie* obvious from the purpose disclosed in the references (to immediately shift to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power). Therefore, as stated in the last Office Action, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to, after the second changing section changes the monitoring timing of the first communication method of AAPA Figure 4, not set the suspend time as suggested by AAPA's Figure 3C for the advantages of performing any conventional processing performed in the lxEVDO system (see page 7, lines 16-18 of original specification) and immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power. Applicant argues that the claimed invention produces unexpected and fruitful results contrary to the prior art's teaching (Remarks: page 11). In response, a showing of unexpected results must be based on evidence, not argument or speculation. *In re Mayne*, 104 F.3d 1339, 1343-44, 41 USPQ2d 1451, 1455-56 (Fed. Cir. 1997).

Specification

3. The amendment filed on 3/2/2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: rephrasing page 7, lines 16-18 under the Brief Description of the Drawings section to delete Fig. 3C from the original disclosure that stated that Figs. 3A to 3C are timing charts showing processing performed in the lxEVDO system during a conventional suspend time introduces new matter into the disclosure as originally filed. Although a rewording (rephrasing) of a passage where the same meaning remains intact is permissible, the exclusion of Fig. 3C from the figures that were admitted as being conventional in the originally filed specification, changes the meaning of the passage, the scope of what was originally disclosed is altered and, therefore, constitutes a new matter into the specification. Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

4. Figure 3C should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (See *Response to Arguments* section above). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter "AAPA").

Regarding claim 3, AAPA discloses a wireless communication terminal (Background Art: page 1, line 25 through page 2, line 7), which performs wireless communication using each of a first communication protocol and a second communication protocol (Background Art: page 1, line 25 through page 2, line 7; note the 1xEVDO and CDMA2000 1x, respectively) and enables to be in an idle state with both protocol (Background Art: page 2, lines 17-24), comprising:

a setting section that sets a suspend time (Figs. 3A-3B and 4; note that this figures are Prior Art) for detecting an incoming call from a base station (Figs. 3B and 4; note the "page") using the first communication protocol (Fig. 3B and 4; note the 1xEVDO) subsequent to completion of communication with the base station using the first communication protocol (Background Art: page 3, lines 4-11; page 12, lines 12-25; note that this section constitutes an admitted prior art statement since only that which is old and/or known is disclosed);

a first changing section that changes a monitoring timing of the second communication protocol (Fig. 4; Background Art: page 2, lines 8-24; page 16, line 18 through page 17, line 3;

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note that as a result of an idle handoff in the CDMA2000 1x system (the second communication protocol) the timing of system monitoring may change); and

a second changing section that changes a monitoring timing of the first communication protocol by communicating with the base station when the first changing section changes the monitoring timing of the second communication protocol (Fig. 4; Background Art: page 2, lines 8-24; page 16, line 18 through page 17, line 3; note that as a result of an idle handoff in the CDMA2000 1x system (the second communication protocol) the timing of system monitoring may change; and in this case, the timing of monitoring the 1xEVDO system (the first communication protocol) must be changed).

AAPA's embodiment discussed above (i.e., Figs. 3A-3B and 4) fail to specifically disclose wherein the setting section does not set the suspend time after the second changing section changes the monitoring timing of the first communication protocol by communicating with the base station.

In the alternate embodiment of Fig. 3C, which as explained above constitutes an admission of prior art, it is shown a timing chart of a case where a suspend time is not set. That is, AAPA discloses wherein the setting section does not set the suspend time (Fig. 3C; page 14, lines 11-12; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed).

Furthermore, AAPA's Figure 4 shows that after the second changing section changes the monitoring timing of the first communication method protocol by communicating with the base station, the 1xEVDO system is in the active state. Figs. 3A-3C show conventional timing charts showing processing performed in the 1xEVDO system (see page 7, lines 16-18 of original

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specification and *Response to Arguments* section above). Note that all of the timing charts of figures 3A to 3C commence in the active state (i.e., "comm" state).

One of ordinary skill in this art at the time of invention by applicant, being given AAPA's Figures 3A to 3C and 4, would reasonably recognize that any of the situations presented in Figures 3A to 3C would apply after the 1xEVDO system is in the active state, which occurs, according to figure 4, after the second changing section changes the monitoring timing of the first communication method by communicating with the base station.

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to, after the second changing section changes the monitoring timing of the first communication method of AAPA Figure 4, not set the suspend time as suggested by AAPA's Figure 3C for the advantages of performing any conventional processing performed in the 1xEVDO system (see page 7, lines 16-18 of original specification and *Response to Arguments* section above) and immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power.

Regarding claim 4, AAPA discloses the wireless communication terminal according to claim 3 (see above), wherein the first communication protocol is a 1x Evolution Data Only system (Fig. 4; (Background Art: page 1, line 25 through page 2, line 7) and the second communication protocol is a Code Division Multiple Access 2000 1x system (Fig. 4; (Background Art: page 1, line 25 through page 2, line 7).

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Regarding claims 7-8, which recites a method version of claims 3-4, see rationale as discussed above, i.e., claims 7-8 are rejected with the same grounds and for the same reasons/motivations explained above.

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIVELISSE SANTIAGO-CORDERO whose telephone number is (571)272-7839. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARIVELISSE SANTIAGO-CORDERO/
Examiner, Art Unit 2617